

REMARKS

I. Double Patenting Rejections

Claims 2, 6, 8-15, and 35 were rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over various claims in U.S. Patent No. 6,533,720. In response to this rejection, Applicant again submits herewith the appropriate terminal disclaimer and fee. No reason was given for the Examiner's prior disapproval of the previously-submitted terminal disclaimer, and Applicant submits that the terminal disclaimer should be approved. In view of these submissions, Applicant respectfully submits that the obviousness-type double patenting rejections have been overcome.

II. 35 U.S.C. § 103 Rejections Based on Goodman and Green

A. Introduction

Each of the independent claims (Claims 2, 6, 8, 12, 15, and 35) were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of the proposed combination of U.S. Patent No. 4,567,880 to Goodman and U.S. Patent No. 6,221,007 to Green. The basis of those rejections is that Goodman teaches an endoscope valve assembly with (1) a mounting surface that comprises a surface of a mounting pad comprising a resilient material and separately formed from the housing and (2) a mounting surface shaped to allow the endoscope valve assembly to fit on medical endoscopes with different shapes, which are features recited in various ones of the independent claims. However, because Goodman does not disclose these features and because Goodman teaches away from the proposed combination, Applicants respectfully request reconsideration and withdrawal of those rejections.

B. Goodman Does Not Teach the Elements Asserted in the Office Action

As shown in Figure 1 of Goodman, the endoscopic device 10 in Goodman is made up of three separate components: a sheath 12, a valve-bridge assembly 16, and a telescope portion 14. It is important to note that the valve-bridge assembly 16, which is asserted to correspond to Applicant's recited endoscope valve assembly, is an integral part of the endoscopic device 10 because, without the presence of the valve-bridge assembly 16, the sheath 12 and telescope portion 14 could not join together to form a workable endoscopic device 10. Accordingly, the valve-bridge assembly 16 in Goodman serves not only as a valve but also as a necessary mechanical "bridge" between the sheath 12 and telescope portion 14.

In contrast, an endoscope valve assembly of a preferred embodiment is designed to be used as an "add-on" component to an existing endoscope rather than an integral component of an endoscope, as in Goodman. The "mounting surface" elements recited in the independent claims are directed to this "add-on" feature. Specifically, each of the independent claims recite that the endoscope valve assembly comprises a mounting surface shaped to allow the endoscope valve assembly to fit on medical endoscopes with different shapes. Goodman does not teach this feature. Because Goodman's valve-bridge assembly 16 is an integral part of the endoscopic device 10, the valve-bridge assembly 16 does not have a housing with a mounting surface shaped to allow it to fit on endoscopes with different shapes. Indeed, the valve-bridge assembly 16 does not "fit on" an endoscope because the valve-bridge assembly 16 is part of the endoscope itself (i.e., there is no endoscope unless the valve-bridge assembly 16 is assembled with the sheath 12

and telescope portion 14).¹ Even if the valve-bridge assembly 16 is considered to “fit on” an endoscope, it only fits on an endoscope of the exact shape as shown in Goodman because the mechanical coupling components on the valve-bridge assembly 16 are specifically designed to fit with the sheath 12 and telescope portion 14 in Goodman. Accordingly, the valve-bridge assembly 16 in Goodman does not have a housing with a mounting surface shaped to allow it to fit on endoscopes with different shapes, as recited in each of the independent claims.

Independent Claims 2, 6, and 12 further recite that the mounting surface comprises a surface of a mounting pad comprising a resilient material and separately formed from the housing. There is absolutely no disclosure of this feature in Goodman. The valve-bridge assembly 16 in Goodman uses rigid pins 52 to mate with a pair of inwardly-facing alignment notches 36 on a locking ring 34 of a coupling piece 30 of a sheath 12. There is absolutely no disclosure in Goodman of a mounting pad comprising a resilient material, as recited in independent Claims 2, 6, and 12. This difference provides an additional ground of patentability for those claims.

In summary, because Goodman does not disclose the elements that are the basis of the rejections of independent Claims 2, 6, 8, 12, 15, and 35, Applicant respectfully submits that the rejections of those claims and their dependent claims should be withdrawn.

C. Goodman Teaches Away from the Proposed Combination

In the Office Action, it was asserted that it would have been obvious to secure the valve assembly in Goodman to an endoscope using a strap. Applicant respectfully disagrees. As

¹ In the latest Office Action, the Examiner points out that the valve unit 46 in Goodman is mounted on the bridge element 42 of the valve-bridge assembly 16 to show that the valve unit 46 does “fit on” the endoscope. However, this merely means that the value unit 46 fits on the valve-bridge assembly 16, not that the valve-bridge assembly 16 fits on an endoscope, as recited in the claims.

discussed above, the valve-bridge assembly 16 in Goodman serves not only as a valve but also as a necessary mechanical “bridge” between the sheath 12 and telescope portion 14. Without the mechanical connection provided by the valve-bridge assembly 16, the sheath 12 and telescope portion 14 could not join together to form a workable endoscopic device 10. Accordingly, using a strap to join the valve-bridge assembly 16 to the sheath 12 or telescope portion 14 would render the endoscopic device 10 in Goodman inoperable. As such, Goodman teaches against the proposed combination.

III. 35 U.S.C. § 103 Rejections Based on Jones and Green

Independent Claims 8, 15, and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of the proposed combination of U.S. Patent No. 5,201,908 to Jones and Green. Independent Claims 8, 15, and 35 recite a mounting surface that is shaped to allow the endoscope valve assembly to fit on medical endoscopes with different shapes. This feature is not shown in Jones (and is also not shown in Green). As shown in Figure 9 of Jones, the removable attachment 102 that carries the valve system 116 has a trapezoidal-like shape that exactly matches the trapezoidal-like shape of the endoscope 100. In this way, the removable attachment 102 fits onto the endoscope 100 in a mating fashion. Because of the unique shape of the removable attachment 102, the valve system 116 and attachment can only fit on endoscopes with the same shape as the endoscope 100 shown in Figure 9. If an endoscope of a different shape were used, the different shape would not mate with the shape of the removable attachment 102. Accordingly, Jones does not teach a mounting surface that is shaped to allow the endoscope valve assembly to fit on medical endoscopes with different shapes, as recited in independent Claims 8, 15, and 35.

As yet another ground of patentability, independent Claims 8, 15, and 35 each recite an outlet port configured to be releasably connected to an irrigation port of a medical endoscope. This feature is not shown in Jones. Jones describes a sheath for protecting an endoscope from contamination. To allow an endoscope to be used multiple times without sterilization, a protective sheath is placed over the endoscope to prevent contamination of the exterior surface of the endoscope. The endoscope in Jones does not have an irrigation port. Accordingly, Jones teaches that channels of the protective sheath are used instead of the irrigation port of a medical endoscope. (Even if an endoscope with an irrigation port were used, the valve assembly would be connected to the channels of the protective sheath instead of to the irrigation port of the endoscope. Otherwise, water, air, or suction supplied by the irrigation port would be blocked by the closed end portion of the protective sheath.)

As shown in Figure 9 of Jones, the outlet port of the valve assembly is connected to the channels of the disposable protective sheath placed over the endoscope. Accordingly, the outlet port of the valve assembly in Jones is not connected to the irrigation port of the endoscope, and one skilled in the art would not have been motivated to further modify Jones to connect the outlet port of the valve assembly to the irrigation port of the endoscope because Jones teaches away from such a modification. Jones specifically states that “[i]t is an important feature of the present invention that access channels 60 extend alongside the endoscope’s flexible portion 16 ***rather than through the endoscope*** as in many prior art instruments.” Col. 5, lines 47-51 (emphasis added). Jones further states that connecting the outlet port of a valve assembly to an irrigation port of an endoscope would contaminate the endoscope and “fundamentally differs from the present invention.” Col. 1, lines 60-63.

In the latest Office Action, the Examiner argues that the irrigation ports in Jones are part of the endoscope. However, as is clear from the discussion above, that is not the case.

In conclusion, because the proposed combination does not teach each and every element of independent Claims 8, 15, and 35, the 35 U.S.C. § 103(a) rejections of those claims and their dependent claims should be withdrawn.

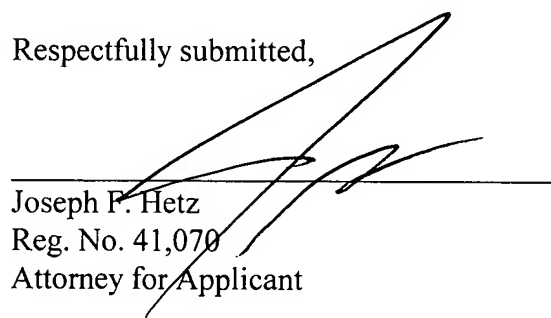
IV. Conclusion

In view of the foregoing remarks, Applicant respectfully submits that this application is in condition for allowance. Reconsideration is respectfully submitted. It should be noted that while only some elements of the independent claims were discussed above, other elements of the independent claims, as well as the dependent claims, provide additional grounds of patentability. Applicant reserves the right to present these additional grounds at a later time, if necessary.

If there are any questions concerning this Response, the Examiner is invited to contact the undersigned attorney at (312) 321-4719.

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Respectfully submitted,



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